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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,278	09/30/2002	Jeffrey C. Leung	013341.000021	5691

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EXAMINER	
DAWSON, GLENN K	

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/065,278	LEUNG ET AL.	
	Examiner	Art Unit	
	Glenn K. Dawson	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17-140* is/are pending in the application.

4a) Of the above claim(s) *21-33,35-54,67-78 and 85-140* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-20,34,55-66 and 79-84* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1-20,4-18,5-10-06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01-20-2006 has been entered.

Election/Restrictions

Applicant's election with traverse of group I, species I in the reply filed on 06-01-2006 is acknowledged. The traversal is on the ground(s) that though the species are patentably distinct, examining claims to all the species would not be a burden on the examiner. This is not found persuasive because another examiner examined and allowed the case identified as 10/065280. Additionally, the examiner contends that it would indeed be burdensome to not only search, but also to examine and prosecute claims to each of the claimed species, especially in view of the fact that each species has associated with it a set of dependent claims. Therefore, even though the search for all the dependent claim material if done for one of the species would be usable for the others, the examiner would still be burdened by the references which potentially disclose these features may not be combinable with a reference showing each specific species. The shear number of the claims to examine and offer rejections places an undue burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 21-33,35-54,67-78 and 85-140 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 06-01-2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 17-20 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alcamo-3123077 in view of Granger-5123911.

Alcamo discloses a barbed suture with helically positioned barbs. However, the ratio of the suture diameter to needle diameter is not disclosed. Additionally, the barbs being in a twist cut multiple spiral disposition is not disclosed. However, the examiner notes that the twist cut is really a product-by-process limitation. Once the cuts are made after the suture has been twisted, the suture is unwound. The resulting pattern of the cuts is merely a multiple spiral. Since Alcamo discloses a suture with barbs which are in multiple spirals, this limitation is met. As for the specific spirality angle, as these were afforded no particular significance in the specification, were not disclosed as solving any particular problem or being for any particular purpose, the examiner contends that such

angles would be obvious design choices, as the applicant's invention would work equally as well with the undisclosed spirality angle of the Alcamo's barbs.

Granger discloses that it was known to attach sutures to suturing needles; wherein the diameter of the needle is equal to the diameter of the suture. This ratio would fall within the claimed ratio. It would have been obvious to have attached the barbed suture of Alcamo to an equal diameter suture needle, in order to facilitate the attachment process and to produce a stronger suture/needle combination which can easily traverse through tissue.

Claims 55-66 and 79-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alcamo-3123077 in view of Granger-5123911, as applied above, and further in view of Buncke-5931855.

Alcamo as modified by Granger makes obvious the invention as claimed with the exception of the suture materials. Buncke, discloses the claimed suture materials. It would have been obvious to have made the Alcamo/Granger suture out of the suture materials disclosed by Buncke, as these materials to tailor the suture to the procedure... e.g. for certain procedures, it would be desirable for the suture to be non-absorbable and others it would be more desirable for the sutures to be absorbable.

Claims 17-20,34,55-66 and 79-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buncke-5931855 in view of Granger-5123911.

Buncke discloses a barbed suture with helically positioned barbs. The suture is formed of absorbable or non-absorbable material. However, the ratio of the suture diameter to needle diameter is not disclosed. Additionally, the barbs being in a twist cut

multiple spiral disposition is not disclosed. However, the examiner notes that the twist cut is really a product-by-process limitation. Once the cuts are made after the suture has been twisted, the suture is unwound. The resulting pattern of the cuts is merely a multiple spiral. Since Buncke discloses a suture with barbs which are in multiple spirals, this limitation is met. As for the specific spirality angle, as these were afforded no particular significance in the specification, were not disclosed as solving any particular problem or being for any particular purpose, the examiner contends that such angles would be obvious design choices, as the applicant's invention would work equally as well with the undisclosed spirality angle of the Buncke's barbs.

Granger discloses that it was known to attach sutures to suturing needles; wherein the diameter of the needle is equal to the diameter of the suture. This ratio would fall within the claimed ratio. It would have been obvious to have attached the barbed suture of Buncke to an equal diameter suture needle, in order to facilitate the attachment process and to produce a stronger suture/needle combination which can easily traverse through tissue.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Glenn K Dawson
Primary Examiner
Art Unit 3731

Gkd
27 July 2006